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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,018	08/18/2003	Karen G. Klaers	163.1236USC1	2964
23552	7590	03/27/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DELCOTTO, GREGORY R	
			ART UNIT	PAPER NUMBER
			1751	
DATE MAILED: 03/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,018	Applicant(s) KLAERS ET AL.	
	Examiner Gregory R. Del Cotto	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-28, 30-32 and 34-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-28, 30-32, and 34-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 25-28, 30-32, and 34-50 are pending. Applicant's arguments and amendments filed 1/9/06 have been entered.

Objections/Rejections Withdrawn

The following Objections/Rejections as set forth in the Office action mailed 9/9/05 have been withdrawn:

The rejection of Claim 33 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to the cancellation of this claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25-28, 30, 31, and 34-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addison et al (US 5,801,137).

Addison et al teach a detergent composition designed for use in automatic dishwasher machines. See column 1, lines 10-30. The compositions comprise a detergent builder system, an organo diphosphonic acid, an organic polymer containing acrylic acid or its salts. See column 3, lines 60-69. Additionally, antiredeposition agents may be used in the compositions including polyethylene glycols having a molecular weight of between 1000 to 10,000. See column 5, lines 55-69. Additionally, a highly preferred component is a surfactant system comprising anionic, cationic, nonionic, ampholytic, and zwitterionic surfactants in amounts 0.5% to 40% by weight. Suitable anionic surfactants include sulfate surfactants, anionic sulfonate, magnesium salt of an anionic carboxylate surfactant etc. See column 8, lines 1-60. Note that, the Examiner maintains that the magnesium salt of the anionic carboxylate surfactant would be encompassed by the alkaline earth metal salt as recited by instant claims 10-13. Suitable nonionic surfactants include polyhydroxy fatty acid amide surfactants, nonionic condensates of alkyl phenols, alkylpolysaccharide surfactants, fatty acid amide surfactants, etc. See column 10, line 40 to column 11, line 45. Sequestrants may also be used in amounts from 0.05% to 20% by weight and suitable sequestrants include organo aminophosphonates, EDDS, etc. See column 15, lines 25-60. Additionally,

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the compositions may comprise a suds suppressing system in amounts from 0.01% to 15% and include silicone antifoam compounds, etc. See column 17, line 40 to column 18, line 69. Additionally, the compositions may contain a builder system which may include a water soluble carboxylate. Additional builders include alkali metal bicarbonates, borates, phosphates, etc. See column 6, lines 1-20. Note that, the Examiner asserts that these salts are encompassed by the broad terminology "alkali metal salt" as recited by the instant claims. Addison et al do not teach, with sufficient specificity, a solid detergent composition containing an anionic surfactant, an alkali metal salt, alkyl polyglycoside, a nonionic surfactant, a hardening agent, and the other requisite components of the compositions in the specific proportions as recited by the instant claims. Note that, with respect to instant claim 25, this is a product by process claim; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Note that, the Examiner asserts that the teachings of Addison et al would suggest compositions having the same properties as recited by the instant claims because Addison et al suggest compositions containing the same components in the same components as recited by the instant claims.

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Addison et al do not teach, with sufficient specificity, a solid detergent composition containing an anionic surfactant, an alkali metal salt, alkyl polyglycoside, a nonionic surfactant, a hardening agent, and the other requisite components of the compositions in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a solid detergent composition containing an anionic surfactant, an alkali metal salt, alkyl polyglycoside, a nonionic surfactant, a hardening agent, and the other requisite components of the compositions in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar properties with respect to other disclosed components, because the broad teaching Addison et al suggest a solid detergent composition containing an anionic surfactant, an alkali metal salt, alkyl polyglycoside, a nonionic surfactant, a hardening agent, and the other requisite components of the compositions in the specific proportions as recited by the instant claims.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addison et al (US 5,801,137) as applied to claims 25-28, 30, 31, and 34-50 above, and further in view of Rolando et al (US 5,876,514).

Addison et al are relied upon as set forth above. However, Addison et al do not teach use of an acetate salt as recited by instant claim 32.

Rolando teach an alkaline warewashing detergent composition that can contain a critical amount of a nonionic rinse agent that when used in automatic warewashing machines permits the use of a potable water rinse without the addition of a separate

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rinse agent. The detergent can be in the form of a particulate, pelletized or a block solid. See Abstract. The composition may contain a solidifying agent when used as a solid block. The solidifying agent may provide for controlled dispensing by using solidification agents which have a relative aqueous solubility. Suitable agents which may be hardening/solidifying agents include urea, calcium carbonate, sodium acetate, etc. These solidifying agents are used in amounts which promote solubility and the requisite structural integrity for the given application. See column 9, line 30 to column 10, line 40.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use an acetate salt in the cleaning composition taught by Addison et al, with a reasonable expectation of success, because Rolando et al teach the use of hardening agents such as sodium acetate in a similar solid detergent composition which provide controlled dispensing and structural integrity and, further, Addison et al teach the formation of solid detergent compositions in general.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25-28, 30-32, and 34-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,387,870. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-22 of US 6,387,870 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a solid detergent composition containing an anionic surfactant, an alkali metal salt, alkyl polyglycoside, a nonionic surfactant, a hardening agent, and the other requisite components of the compositions in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar properties with respect to other disclosed components, because claims 1-22 of US 6,387,870 suggest a solid detergent composition containing an anionic surfactant, an alkali metal salt, alkyl polyglycoside, a nonionic surfactant, a hardening agent, and the other requisite components of the compositions in the specific proportions as recited by the instant claims.

Response to Arguments

With respect to Addison et al, Applicant once again states that while Addison et al mention polyethylene glycol, it is not mentioned as a hardening agent and therefore there is no prima facie case of obviousness. In response, note that, the Examiner maintains that while Addison et al do not teach the use of polyethylene glycol as a

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hardening agent, the polyethylene glycol as taught by Addison et al is the same polyethylene glycol having the same molecular weight as recited by the instant claims and would have the same hardening properties as the polyethylene glycol as recited by the instant claims. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant. Furthermore, while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the Applicant to make the claimed invention. See MPEP 2144.

Also, Applicant again states that Addison et al fail to teach or suggest the creation of a solid block cleaning composition as recited by claim 25 and the block is not formed through compression alone but through a heating and extrusion process. In response, note that, Addison et al teach that the compositions may be formulated as tablets (See column 19, lines 40-46) which would be a type of solid block and would fall under the generic category of "solid block" as recited by the instant claims. Also, claim 25 is a composition claim and not a method claim; Addison teaches the same solid block composition as recited by the instant claims. While claim 25 is a product by process claim, in the absence of evidence, patentability of the product in a product by process claim is not dependent on the product of production, but on the composition itself. Applicant has provided no evidence showing the criticality of the process of production as recited by instant claim 25. Further, as stated above, the patentability of

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a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Additionally, casting is a common method of forming tablets which fall under the generic category of solid blocks as recited by the instant claims.

With respect to Rolando et al, Applicant states that there is no sufficient disclosure by Rolando et al that would have suggested modifying Addison et al to achieve the presently claimed invention containing a polyethylene glycol having a molecular weight from 1000 to 100,000. In response, note that, the Examiner maintains that Rolando et al is relied upon as a secondary reference for its teaching of an acetate salt and Rolando et al provides clear motivation to use such an acetate salt in the composition as taught by Addison et al for the reasons set forth above.

With respect to the double patenting rejection over claims 1-22 of US 6,387,870, Applicant states that a terminal disclaimer has been submitted which is sufficient to overcome the double patenting rejection. In response, note that, there is no terminal disclaimer of record present in the case and it appears that either Applicant has forgotten to file the terminal disclaimer or that it has gotten separated from the case file. Thus, the double patenting rejection over claims 1-22 of US 6,387,870 has been maintained for the reasons of record set forth above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
March 20, 2006